



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,134	09/08/2003	Valerie De La Poterie	230251US0	8666
22850	7590	02/11/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			VENKAT, JYOTHSNA A	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			1615	
NOTIFICATION DATE	DELIVERY MODE			
02/11/2008	ELECTRONIC			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/656,134	DE LA POTERIE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JYOTHSNA A. VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 19 November 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 31-34 and 36-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 31-34, 36-46 and 50-53 is/are rejected.
- 7) Claim(s) 47-49 and 54-56 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

Receipt is acknowledged of amendment filed on 11/19/07. Claim 35 has been canceled as per applicant amendment dated 11/19/07. Claims 31-34, and 36-56 are pending in the application and then independent claims are examined to the extent that it reads on the elected species belonging to semi-crystalline polymer, which is stearyl acrylate-N-vinyl pyrrolidone.

### ***Claim Rejections - 35 USC § 102***

Claims 31-44, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 7,129,276 ('276).

See example 2 for the claimed species and see example 5 for the lipstick formulation. Hydrogenated isoparaffin reads on the claimed fatty phase (oil). Stearyl acrylate/NVP is the species belonging to crystalline polymer (specific compound). Example 5 has no water and this reads on claim 43. See col.12, lines 43-46 for fatty phase weight. See col.14, line 36 for water and this reads on claim 44 and 46. See col.13, lines 19-43 for pigments and this reads on claims 50-52. See paragraph bridging col.s 15-16 for fillers of claim 53. See col.16, lines 43-49 for claim 54 and making up (make up) for keratin substance reads on claim 56. Since the semi crystalline polymer species is same the claimed property claimed in claims 32-34, 37 is inherent since the compound and its properties are inseparable. It is true for claimed property of oil claimed in claim 41. Note that hydrogenated isoparaffin belongs to oil.

### ***Response to Arguments***

Applicant's arguments filed 11/19/07 have been fully considered but they are not persuasive.

Applicants argue that patent '276 does not disclose compositions containing 10-60% fatty phase. The specification does not teach this requirement, and the exemplified compositions all have more than 60% fatty phase. Nowhere does Ferrari disclose a composition, particularly mascara, having at least 45% solid content, 10-60% fatty phase and no waxes.

In response to the above argument, patent '276 teaches compositions without waxes at col.3, ll 33-42. See below

Surprisingly, it has been found that the use of semi-crystalline polymers in combination with solid particles and at least one dispersing agent, even in the absence of conventional wax and/or of filler, makes it possible to obtain a stable stick, such as for using in making up, the application of which can result in a colored, uniform, glossy and nonsticky film which has good coverage and which does not migrate, with restriction of the sedimentation of the particles, colored particles for instance, at the end of the stick. <sup>3</sup>

Patent '276 also teaches 5-90% at col.12, ll 43-46. The claimed fatty phase is within the fatty phase disclosed in the patent. see below.

The fatty phase can represent, in practice, from 5 to 99% of the total weight of the composition, such as from 20 to <sup>45</sup> 80%. It may represent at least 60% of the total weight of the composition.

Claims 31-42, 44-47 and 50-53 are rejected under 35 U.S.C. 102(e) as being anticipated by PGPUB 2003/0165451 A1.

See example 2 for the claimed species and see example 5 for the care cream. Silicone oil or Isohexadecane or Parleam reads on the oil. Stearyl acrylate/NVP is the species belonging to crystalline polymer (specific compound). Example 5 has glycerol and it reads on claims 44-46

hydrophilic organic solvent, which is polyols having 2 carbon atoms and the amount is within the claimed range and it reads on claim 43. See paragraph 92 for fatty phase weight. See col.14, line 36 for water and this reads on claim 44 and 46. See paragraph 129 for dyestuff and this reads on colorant and dyes of claims 50-52. See paragraph 129 for remaining ingredients of claim 53. See paragraph 135 and 141 for claim 54. Since the semi crystalline polymer species is same the claimed property claimed in claims 32-34, 37 is inherent since the compound and its properties are inseparable. The same is true for claimed property of oil claimed in claim 41. Note that hydrogenated isoparaffin belongs to oil.

***Response to Arguments***

Applicant's arguments filed 11/19/07 have been fully considered but they are not persuasive.

Applicant argue that PGPUB document does not disclose compositions containing at least 45% solid content and the specification does not teach this requirement, and the exemplified compositions all have less than 45% solid and the document does not disclose a composition, particularly a mascara, having at least 45% solid content, 10-60% fatty phase and no waxes.

In response the PGPUB document under example teaches 60% of active material and the PGPUB document teaches oily phase in an amount from 10-95% by weight and the claimed fatty phase is within the amount disclosed in the patent.

***Allowable Subject Matter***

Claims 47-49 and 54-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/JYOTHSNA A. VENKAT/ Ph. D  
Primary Examiner  
Art Unit 1615**

\*\*\*